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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,674

09/02/2005

Gabriele Grandini

2005-0040A

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EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

02/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,674	Applicant(s) GRANDINI, GABRIELE	
	Examiner JILA M. MOHANDESI	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/29/05, 01/31/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/28711 (Rauch) in view of Polegato (US 5,983,524). Rauch discloses all the components of the claimed item of footwear, i.e. an outsole 2, 3; (see page 6, lines 1-33 and p.7, lines 19-38); said outsole 2,3 consists also of "a monolithic piece" (see figures 1, 3) "of synthetic material" ; a grating-like element 4b; a pliable sheet insert 1; an insole 10 and an upper 9 (see figures 1,3, 6; page 6, lines 1-33 and p.7, lines 19-38). Rauch does not appear to disclose the pliable insert is made of water-repellent leather, the insole is made of water repellent leather, leather board or fibreboard; said upper being made of a water repellent leather or a combination thereof with synthetic materials and for the insole to be provided with through holes in the forepart thereof to

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aid to moisture breathability of the insole and insock (see Figure 1 and 2). Polegato discloses that it is desirable to make shoe parts from vapor-permeable material such as leather, (see column 2, lines 40-45 and lines 58-63). Polegate also discloses that it is desirable to provide the insole (178) and the filler layer (18) with through holes in the forepart thereof to aid to moisture breathability of the footwear. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to make the different parts of Rauch's footwear from vapor-permeable leather and to provide through holes in the insole as taught by Polegato to improve breathability and moisture expelling properties of the footwear.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 13 above and further in view of Berger et al.

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(Pub No. US 2002/0017036). Rauch as modified above discloses all the limitations of the claims except for the specifics of the grate-like element. Berger discloses grate-like elements 11, 12 and 13 which could be circular, rectangular, and elliptical or any combination thereof (see column 6, lines 62-67 thru column 7, and lines 1-6). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to make the grate-like elements Rauch-Polegato with curved, parallel or latticed bar elements as taught by Berger, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

7. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 13 above and further in view of Larson et al. (US 4,689,899). Rauch as modified above discloses all the limitations of the claims except for the insole being covered by an insock which is formed of different materials joined together by stitching seam. Larson discloses an insole being covered by an insock which is formed of different materials joined together by stitching seam which is resistant to compression, and will readily evaporate absorbed moisture while providing effective insulation. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to cover the insole of Rauch-Polegato with a stitched together multi-layered insock to readily evaporate absorbed moisture while providing effective insulation.

With respect to the material of the multi-layers of the insock, it would have been obvious to one of ordinary skill in the art to modify the material of the insock, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 20, Polegato discloses that an optional heel seat made of soft leather with absorbent latex rubber can be arranged in the heel area.

With respect to claim 21, Polegato discloses that it is desirable to make the layers of the insole with through holes to aid in moisture breathability of the footwear. Therefore, it would have been obvious to one of ordinary skill in the art to provide through holes to the layers of the insock of the modified insole of Rauch as taught by Polegato for better breathability.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are footwear analogous to applicant's instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JILA M. MOHANDESI whose telephone number is (571)272-4558. The examiner can normally be reached on MONDAY-FRIDAY 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey YU can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

JMM
02/12/09